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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,230	11/19/2003	Ronald W. Hall	10971833-3	6942
7590 01/11/2006			EXAMINER	
HEWLETT-PACKARD COMPANY			LIANG, LEONARD S	
Intellectual Property Administration			ART UNIT	
P. O. Box 272400			PAPER NUMBER	
Fort Collins, CO 80527-2400			2853	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/717,230	Applicant(s) HALL ET AL.	
	Examiner Leonard S. Liang	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 19-23 and 25-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 19-23 and 25-27, drawn to a method of providing ink to a printing system, the printing system including a docking bay having therein a first fluid inlet for receiving pressurized ink, the method comprising: inserting a pump module into the docking bay of the printing system to couple the pump module including a second fluid inlet for receiving ink, an air purge apparatus, and a pressurizing apparatus for increasing the fluid pressure of the ink before providing the ink to the first fluid inlet; coupling an ink container to the second fluid inlet; and removing air trapped within the pump module using the air purge apparatus, classified in class 347, subclass 92.
- II. Claims 28-34, drawn to a method for providing ink to a printing system, the printing system including a plurality of fluid inlets, the method comprising: coupling a pump module to the plurality of fluid inlets, the pump module including a plurality of fluid outlets that engage the plurality of fluid inlets, and a plurality of pressurizing apparatuses for increasing the fluid pressure of the ink before providing ink to the plurality of fluid inlets; and coupling a plurality of ink containers having fluid outlets to the pump module, the pump module including a plurality of fluid inlets that receive the fluid outlets of the plurality of ink containers, classified in class 347, subclass 85.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a method for providing ink to a printing system can exist without an air purge apparatus that removes air trapped within the pump module. Take, for example, applicant's specified figure 21 as compared to applicant's specified figure 22. Figure 21 provides a method of providing ink to a printing system without an air purge apparatus. Furthermore, the combination as claimed does not require a docking bay coupling a pump module to a first fluid inlet within the docking bay in order to provide ink to a printing system. An example might be Kashio (US Pat 3950761), which clearly discloses a method of providing ink to a printing system, but which applicant contends does not disclose a docking bay. The subcombination has separate utility such as removing air from a pump. The uses of an air purge apparatus are well known to extend outside the field of ink jet printing. Similarly, a docking bay has utility other than helping to transfer ink. It can be used for transfer of a variety of other fluids, such as water, gas, biological fluids, etc...

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The examiner apologizes for not making this restriction requirement sooner, but it was only upon reading the applicant's response to arguments that the examiner was made fully aware

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of the need for restriction. Furthermore, the applicant's amendments to claim 19 contributed in further distinguishing the divergent subject matter between claims 19 and 28.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard S. Liang whose telephone number is (571) 272-2148.

The examiner can normally be reached on 8:30-5 Monday-Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MANISH S. SHAH
PRIMARY EXAMINER